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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,383	10/10/2000	Gertrud Hoetten	2923-120	7142

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EXAMINER

MERTZ, PREMA MARIA

ART UNIT PAPER NUMBER

1646

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,383

Applicant(s)

HOTTEN ET AL.

Examiner

Prema M Mertz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-34⁴³ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24, 26-28, 30-34 is/are rejected.
- 7) ☒ Claim(s) 25, 29³⁵⁻⁴³ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/482,557.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection (10/29/2003). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on has been entered.

Amended claims 24, 25, 29, 35, (11/18/2003) and original claims 26-28, 30-34, 36-43, are pending and under consideration by the Examiner.

Claim rejections-35 USC § 112, first paragraph

2. Claims 24, 26-28, 30-34, are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a protein encoded by the nucleic acid of SEQ ID NO:1 or SEQ ID NO:3, does not reasonably provide enablement for a protein encoded by the DNA of claim 24 (d). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with this claim.

Claim 24, recites "protein.....coded by a DNA moleculewhich hybridizes to the DNA molecules of (a) and (b).... And which encodes a protein...", and therefore the protein encoded by the DNA which is complementary to the DNA of claim 24 (a)-(b) are encompassed by the scope of the claim. The specification does not disclose which proteins one would reasonably expect to succeed in obtaining, if any. The specification has not provided one skilled in the art, the information necessary to produce a protein using the nucleic acid strand complementary to SEQ ID NO:1 or 3. The specification is non-enabling for a protein encoded by

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the complement of a nucleic acid molecule encoding a polypeptide because the specification does not provide the guidance to make a complement of a nucleic acid molecule that could encode a polypeptide having the amino acid sequence as set forth in SEQ ID NO:2 or 4. The instant specification is non-enabling for such, because how can one make a nucleic acid and a complement thereof, both encoding the same amino acid sequence. The specification provides no guidance and in the absence of such a disclosure, a skilled artisan would be unable to make/use the complement of a nucleic acid encoding a polypeptide set forth in SEQ ID NO:2 or 4, as embraced by the claim. For these reasons, it would require undue experimentation to practice the claimed invention.

Claims 26-28, 30-34 are rejected under 35 U.S.C. § 112, first paragraph, insofar as they depend on claim 24 for its limitations.

Claim rejections-35 USC § 112, second paragraph

3. Claims 24, 26-28, 30-34, are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24, sub-part (d), is vague and indefinite in a number of respects. The recitation of "a DNA molecule ..hybridizes with on of the DNA molecules from (a) and (b)" is incorrect because sequences complementary to the sequences specified in claim 24 (a)-(b), are not coding sequences. It is suggested that the claims be amended to recite proteins encoded by DNA that hybridize to the complement of the DNA specified in claim 24 (a)-(b), which claimed polypeptides would be obtained from coding sequences.

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Furthermore, it is unclear from claim 24(d) if the DNA molecule encoding the polypeptide claimed or the DNA molecule it hybridizes to encode the claimed polypeptide.

Claims 26-28, 30-34 are rejected under 35 U.S.C. § 112, first paragraph, insofar as they depend on claim 24 for its limitations.

Conclusion

No claim is allowed.

Claims 25, 29, 35-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

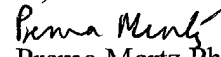
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.

Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Prema Mertz Ph.D.
Primary Examiner
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December 22, 2003